

REMARKS

Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the remarks made herewith.

Pursuant to 37 C.F.R. §§1.136(a) and 1.17(a), a two-month extension of the period for reply, i.e., up to and including March 8, 2005, is respectfully requested. A check for \$225.00 is enclosed in payment of the fee therefor by a small entity. The Commissioner is hereby authorized to charge any other fee occasioned by this paper, or credit any overpayment, to Deposit Account No. 50-0320.

Response to restriction requirement

The Examiner has required restriction to one of the following inventions as required under 35 U.S.C. §121.

- I. Claims 1-21 and 44-46, drawn to a composition that produces weight loss in a mammal, classified in class 424, subclass 725 or class 514, subclass 3, for example.
- II. Claims 22-43, drawn to a method of reducing weight in a patient, classified in class 424, subclass 195.15 or 195.17, for example.

Applicant elects Group I, claims 1-21 and 44-46, with traverse. Applicant hereby asserts the right to file divisional applications directed to non-elected subject matter.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP §803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

Applicant urges that the Restriction Requirement does not meet the both of these criteria as the claims are drawn on the same invention and therefore the search for the groups would overlap. Applicant respectfully points out to the Examiner that the claims in Group II are directed to a method of reducing weight in a patient by administering the weight loss composition as claimed in claim 1. By virtue of the weight loss composition that is common to claims of both Group I and II, the two Groups are indeed related to each other and therefore

constitute the same invention. This is evident from the Office Action at page 2, where the two Groups are both classified in class 424. It is believed that due to the classification of both groups in class 424, examination of both Groups is likely to be co-extensive. Accordingly, examination of these Groups would be expected to significantly overlap, and therefore their examination in a single application would not constitute an undue burden for the Examiner.


The present claims, therefore, represent a web of knowledge and continuity of effort that merits examination in a single application. Thus, reconsideration and withdrawal of the Restriction Requirement are warranted.

Further, it is respectfully urged that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicant as well as to the public. The cost of prosecuting and maintaining so many patents is unreasonable in view of the fact that the two groups are so closely related. Further, the public is inconvenienced, as they will not know whether or not Applicant will file a divisional application to the remaining subject matter.

Accordingly, in view of the foregoing, reconsideration and withdrawal of the restriction requirement are requested, and an early action on the merits is earnestly solicited.

Respectfully submitted,
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